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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/993,600	11/27/2001	Eyal Shavit	216589US2	8696

31665 7590 07/07/2004

PATENT DEPARTMENT
MACROVISION CORPORATION
2830 DE LA CRUZ BLVD.
SANTA CLARA, CA 95050

EXAMINER

BROWN, CHRISTOPHER J

ART UNIT	PAPER NUMBER
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2134

DATE MAILED: 07/07/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/993,600

Applicant(s)

SHAVIT ET AL.

Examiner

Christopher J Brown

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 10 November 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-8,31-38,62-68 and 89-98 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,2,31,32,62,63,89 and 90 is/are rejected.
- 7) ☒ Claim(s) 3-8,33-38,64-68 and 91-98 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 11/27/01 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 2-4.
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: _____.

DETAILED ACTION

Election/Restrictions

1. This application contains claims directed to the following patentably distinct species of the claimed invention: Species I, claims containing Method, Apparatus, Computer Software Product, and Data Storage Medium directed to generating and writing control information to the PMA of a CD, Species II, claims containing Method, Apparatus, Computer Software Product, and Data Storage Medium directed to generating a first and second TOC referring to the same track numbers on the CD, Species III, claims containing Method, Apparatus, Computer Software Product, and Data Storage Medium directed to rearranging the second synchronization symbol to appear before a first synchronization symbol on a CD sector, Species IV, claims containing Method, Apparatus, and Computer Software Product, directed to generating control information to be recorded in synchronization with data, and Species V, claims containing Method, Apparatus, and Computer Software Product, directed to downloading a script to a module to access an updated processing parameter, processing the data with the updated parameter, and recording the processed data.

During a telephone conversation with Jim Sulter on 6/14/04 a provisional election was made of Species I to prosecute the invention of Method, Apparatus, Computer Software Product, and Data Storage Medium directed to generating and writing control information to the PMA of a CD, claims 1-8, 31-38, 62-68, 89-98. Affirmation of this election must

be made by applicant in replying to this Office action. Claims 9-30, 39-61, 69-88, 99-104 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1, 31, 62, and 89 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hira US 5,381,392 in view of Ryan US 5,513,260

As per claims 1, 31, 62 and 89, Hira discloses a method for writing control data to the PMA (TOC) and the program area of a CD, (Col 2 lines 46-50, Col 3 lines 3-9).

Hira does not disclose that an unauthorized CD device is rendered incapable of reading the CD.

Ryan shows that it is desirable that an unauthorized CD device is rendered incapable (shut down) of reading the CD (Col 2 lines 24-35).

It would be obvious to modify Hira with Ryan to prevent CD piracy.

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Claims 2, 32, 63, and 90 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hira US 5,381,392 in view of Ryan US 5,513,260 in view of Udagawa, US 5,706,261.

As per claims 2, 32, 63, and 90, Hira discloses a disc copying system. Hira does not disclose a "disk at once" (DAO) mode.

Udagawa discloses copying in a DAO mode, (Col 1 lines 29-36).

It would be obvious to modify Hira with Udagawa because the DAO mode allows a user to create a "master" copy of a disk.

Allowable Subject Matter

3. Claims 3-8, 64-68, and 91-98 are objected to due to their dependence on rejected independent claims.

Conclusion


4. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Christopher J Brown whose telephone number is 703-305-8023. The examiner can normally be reached on 8:30-6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gregory Morse can be reached on 703-308-4789. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Christopher J. Brown



GREGORY MORSE
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2100